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EXAMINER	
WARDEN, JILL ALICE	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BOYCE D. BURTS

Appeal 2009-013724
Application 09/296,217
Technology Center 1700

Decided: May 17, 2010

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and KAREN M. HASTINGS, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-13. We have jurisdiction under 35 U.S.C. § 6(b).

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[1] On page 2 of the Brief, Appellant listed two related applications in which Notices of Appeal have been filed. Decisions have been rendered for each of them. Appeal No. 2003-0515 corresponds with S.N. 09/296,216. Appeal No. 2003-0604 corresponds with S.N. 09/307,544. Our decision in this case reflects the same outcome rendered in these related applications.

STATEMENT OF THE CASE

Claims 1 and 11 are representative of the subject matter on appeal and are set forth below:

> 1. A lost circulation additive comprising a dry mixture of a water soluble crosslinkable polymer, a crosslinking agent, and a reinforcing material selected from among fibers and comminuted plant materials.
>
> 11. A method of forming a lost circulation fluid comprising:
>
> (a) providing a lost circulation additive comprising a dry mixture of water soluble crosslinkable polymer, a crosslinking agent, and a reinforcing material selected from among fibers and comminuted plant materials; and
>
> (b) contacting the lost circulation additive with water or an aqueous solution to form the lost circulation fluid.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Horner	3,208,524	Sep. 28, 1965
Githens	4,566,979	Jan. 28, 1986
Sydansk	4,989,673	Feb. 5, 1991
House	5,004,553	Apr. 2, 1991
Merrill	5,377,760	Jan. 3, 1995

Claims 1-10 of Application No. 09/296,216, filed April 22, 1999
Claims 1-10 of Application No. 09/307,544, filed April 22, 1999

THE REJECTION(S)

Claims 1, 2, and 7 stand rejected under 35 U.S.C. § 103 as being obvious over Sydansk in view of Githens.

Claims 1-4, and 7 stand rejected under 35 U.S.C. § 103 as being obvious over Merrill and Githens.

Claims 1, 2, and 5-13 stand rejected 35 U.S.C. § 103 as being unpatentable of House in view of Horner and Githens.

Claims 1-13 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of co-pending Application No. 09/296,216 [2], in view of Sydansk, or over claims 1-10 of copending Application No. 09/307,544 [3] in view of Sydansk.[4]

ISSUE AND ANALYSIS

The common issue among all of the 35 U.S.C. § 103 rejections is whether the Examiner has provided a proper factual foundation supporting her conclusion that one of ordinary skill in the art would have expected that the addition of inert solids (for example, sand), before activation with water, rather than after activation with water, would provide no substantial difference in results. (Answer, page 14.)

We note that the prior art can be modified or combined to reject claims as prima facie obvious as long as one of ordinary skill in the art

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[2] This application issued on April 6, 2004 and is now U.S. Patent No 6,716,798.

[3] This application issued on June 15, 2004 and is now U.S. Patent No. 6,750,179.

[4] Because these applications relied upon in these rejections are now U.S. patents, these rejections are no longer provisional.

would have had a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the Examiner's rejection lacks an explanation of how one of ordinary skill in the art would have had a reasonable expectation of success that no substantial difference in effect would occur if one of ordinary skill in the art would have added the sand in Sydansk prior to formation of the gel (i.e., prior to activation with an aqueous solvent) versus after formation of the gel. On page 12 of the Answer, the Examiner states "[t]he addition of inert solids, i.e. sand, would have no effect on the cross linking composition and gelling agent." Yet, the Examiner does not provide facts on the record to support this as knowledge possessed at the time of invention by one of ordinary skill in the art. Due to this lack of factual foundation, we reverse each of the 35 U.S.C. § 103 rejections.

With regard to the obviousness-type double patenting rejections of claims 1-13 (which is no longer provisional; *see* footnote 4, *supra*), over claims 1-10 of 09/296,216 and over claims 1-10 of co-pending application 09/307,544, in view of Sydansk, the Examiner correctly indicates on page 15 of the Answer that Appellant's Brief does not contain an argument which specifies errors regarding these rejections. Appellant's Reply Brief also does not address these rejections. Hence, we affirm each of these rejections.

DECISION

Each of the 35 U.S.C. § 103 rejections is reversed.

Each of the rejections under the judicially created doctrine of obviousness-type double patenting is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

kmm

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